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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/801,425	03/16/2004	Jeremy G. Dunne	LT00043	2057
25235 7590 03/21/2008 HOGAN & HARTSON LLP ONE TABOR CENTER, SUITE 1500 1200 SEVENTEENTH ST DENVER, CO 80202				
EXAMINER				
SAGER, MARK ALAN				
ART UNIT		PAPER NUMBER		
3714				
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Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary

Application No.

10/801,425

Applicant(s)

DUNNE ET AL.

Examiner

M. A. Sager

Art Unit

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 29 November 2007.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-12 and 23-25 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-12 and 23-25 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/S508)
Paper No(s)/Mail Date _____
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date _____
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: _____

Election/Restrictions

1. The restriction requirement is maintained as proper and made final herein (37 CFR 1.144) See MPEP § 821.01.

Claim Rejections - 35 USC § 103

2. Claim 25 is rejected under 35 U.S.C. 103(a) as being unpatentable over either Jenkins or Zeiner-Gundersen each in view of either Johnstone or Mauritz. This holding is maintained from prior action for cited non-amended claim over cited references as in evidence below. Response to Applicants' asserted patentability is provided below and incorporated herein. While features of an apparatus may be recited either structurally or functionally, claims directed to an apparatus must be distinguished from the prior art in terms of structure rather than function. In re Schreiber, 128 F.3d 1473, 1477-78, 44 USPQ2d 1429, 1431-32 (Fed. Cir. 1997) (The absence of a disclosure in a prior art reference relating to function did not defeat the Board's finding of anticipation of claimed apparatus because the limitations at issue were found to be inherent in the prior art reference); see also In re Swinehart, 439 F.2d 210, 212-13, 169 USPQ 226, 228-29 (CCPA 1971); In re Danly, 263 F.2d 844, 847, 120 USPQ 528, 531 (CCPA 1959). "[A]pparatus claims cover what a device is, not what a device does." Hewlett-Packard Co. v. Bausch & Lomb Inc., 909 F.2d 1464, 1469, 15 USPQ2d 1525, 1528 (Fed. Cir. 1990) (emphasis in original). In this case, Applicant has not disputed the findings of fact presented in prior action such as regarding Jenkins. Jenkins discloses a range finding instrument comprising a user input (abstract, 2:26-3:3, 3:66-4:8, 4:46-48, 5:48-51, ref 27), a data store (ref. 67, 69, 71, 73), a processor (ref 65), rangefinder (6:55-68), a display indicating a suggested golf club type (abstract, 2:26-3:3, 6:64-68), a tilt sensor (2:50-56, ref 13), entering a wind speed and direction (2:26-3:3, 3:66-4:4,

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8:18-51) but lacks the processor performing claimed function of 'computing at least one other correlated data set indicative of another golf club type and associated representative user range based upon a relationship in said first correlated data set' or 'computing at least said suggested club type and an associated representative user range for said at least one other club type'. Also, Applicants have not disputed the findings of fact presented in prior action regarding Zeiner-Gundersen. Zeiner-Gundersen discloses a range finding instrument comprising a user input (abstract, 2:13-55, 5:63-66, fig. 5, ref 14), a data store (implicit microprocessor 20 contains memory), a processor (ref 20), rangefinder (ref 24), a display indicating a suggested golf club type (abstract, 2:13-21, 5:23-25, ref 22), a tilt sensor (3:50-52, ref 30, 32), a wind speed and direction sensor (3:52) but lacks the processor performing claimed function of 'computing at least one other correlated data set indicative of another golf club type and associated representative user range based upon a relationship in said first correlated data set' or 'computing at least said suggested club type and an associated representative user range for said at least one other club type'. However, Johnstone discloses average ranges for each of a particular golf club type (3:19-55); while, Mauritz discloses recommending a particular golf club type for a range based on personal data including handicap (abstract, 1:47-2:14, figs. 1-4). Also, admission regarding 'computing at least one other correlated data set indicative of another golf club type and associated representative user range based upon a relationship in first data set' was old and well known to an artisan as remarked in amendment received Nov 29, 2007 on page 8, lines 15-28 is noted. Where a golfer/user may not know the personal performance range of a particular golf club type (such as might occur prior to initial use of a golf club type), it would have been obvious to an artisan at a time prior to the invention to add 'computing at least one other

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correlated data set indicative of another golf club type and associated representative user range based upon a relationship in said first correlated data set' as either a standard range of average user as taught by Johnstone or based on personal performance characteristic such as handicap as taught by either Mauritz to improve the golf device of either Jenkins or Zeiner-Gundersen for the predictable result of entering/providing user data used to suggest a club type including consideration of a new/different golf club type where player has no prior performance history.

Alternatively, 'computing at least one other correlated data set indicative of another golf club type and associated representative user range based upon a relationship in said first correlated data set' does not solve any Applicant stated problem or purpose. While, Jenkins and Zeiner-Gundersen each discloses an instrument having claimed structure including a process to suggest a club based on input of user's golf data but lacks claimed computing. Because Jenkins, Zeiner-Gundersen, Johnstone, Mauritz and admitted prior art process each teach methods of entering or input of user play data used to suggest a golf club, it would have been obvious to an artisan at a time prior to the invention to substitute the method of 'computing at least one other correlated data set indicative of another golf club type and associated representative user range based upon a relationship in said first correlated data set' as an admitted known process or as either a standard range of average user as taught by Johnstone or based on personal performance characteristic such as handicap as taught by Mauritz for the other process of either Jenkins or Zeiner-Gundersen so as to achieve the predictable result of entering or user input of play data used to suggest a club type including for a new/different club type that has no prior performance history. The lack of criticality of claimed process to enter user golf data used to suggest club type is noted in light of admission of process being old and well known.

3. Claim 23 is rejected under 35 U.S.C. 103(a) as being unpatentable over either Jenkins or Zeiner-Gundersen each in view of either Harris (5898484) or Hines (5933224). Applicant has not disputed the findings of fact presented in prior action regarding Jenkins and Zeiner-Gundersen that is reiterated next. Zeiner-Gundersen discloses a device and method teaching entering at least one club type and associated representative user range for said at least one club type to a data store associated with a range finding instrument (2:18-19, 3:39-41 and 56-57, 5:63-6:2, ref 14); determining a range to a selected point on a golf course with said range finding instrument (4:27-31, 4:61-5:7, 5:19-20); extrapolating a suggested club type appropriate to said determined range from said at least one club type and associated representative user range (2:13-55, 3:6-6:18, esp. 5:23-25); and displaying said suggested club type to a user of said range finding instrument (3:56-4:67, 4:61-5:7, 18-25). Similarly, Jenkins discloses a method of an analyzer and club selector (abstract, 2:27-3:3) teaching entering at least one club type and associated representative user range for said at least one club type to a data store associated with a range finding instrument (2:27-35, 2:65-68, 4:46-48, 5:47-51, 6:1-29); determining a range to a selected point on a golf course with said range finding instrument (abstract, 2:59-64, 6:55-68); extrapolating a suggested club type appropriate to said determined range from said at least one club type and associated representative user range (abstract, 2:27-3:3, 6:64-68); and displaying said suggested club type to a user of said range finding instrument (abstract, 2:27-57, 6:64-68). However, as noted by Applicants in their remarks, Jenkins and Zeiner-Gundersen each lack a 'laser' rangefinder. Harris (abstract, 1:41-3:54, 8:22-62, 11:17-20, 19:49-22:8) and Hines (abstract, 2:21-44, 7:3-8:25, 9:50-10:64, 19:14-21:27) each disclose a laser rangefinder. In consideration of US Supreme Court decision in KSR, because Jenkins, Zeiner-Gundersen, Harris

and Hines each teach methods of player input of a range to target, it would have been obvious to an artisan to substitute one method for the other to achieve the predictable result of input of range to target. The improvement for use of laser rangefinder over mil-radian process is implicit in the accuracy of the technology.

4. Claims 1-7, 10-12 and 24 are rejected under 35 U.S.C. 103(a) as being unpatentable over Zeiner-Gundersen in view of either Johnstone or Mauritz as applied to claim 25 above, and further in view of either Harris (5898484) or Hines (5933224); and claims 1-5, 8-12, and 24-25 are rejected under 35 U.S.C. 103(a) as being unpatentable over Jenkins in view of either Johnstone (3059926) or Mauritz (5283732) as applied to claim 25 above, and further in view of either Harris (5898484) or Hines (5933224). Jenkins or Zeiner-Gundersen each in view of either Johnstone or Mauritz suggests a range-finding golfing instrument and method as claimed (*supra*) but each combination lacks a 'laser' rangefinder. Harris (abstract, 1:41-3:54, 8:22-62, 11:17-20, 19:49-22:8) and Hines (abstract, 2:21-44, 7:3-8:25, 9:50-10:64, 19:14-21:27) each disclose a laser rangefinder. In consideration of US Supreme Court decision in KSR, because Jenkins and Zeiner-Gundersen each in view of either Johnstone or Mauritz, Harris and Hines each teach methods of [player] input of a range to target in golf, it would have been obvious to an artisan to substitute one method for the other to achieve the predictable result of input of range to target. The improvement for use of laser rangefinder over mil-radian process is implicit in the accuracy of the technology.

5. Claims 8-9 are rejected under 35 U.S.C. 103(a) as being unpatentable over Zeiner-Gundersen in view of either Harris or Hines, and further in view of either Johnstone or Mauritz as applied to claim 1 above, and further in view of either Jenkins (5294110) or Jones (4136394).

Zeiner-Gundersen in view of either Harris or Hines, and further in view of either Johnstone or Mauritz discloses claimed instrument (supra) except entering a wind speed and direction (where such entry is manual) at least since Zeiner-Gundersen includes a wind speed and direction sensor. Jenkins and Jones each disclose an instrument teaching user input for entering a wind speed and direction for possible alteration of suggested club type based upon determined range. In consideration of US Supreme Court decision in KSR, because Zeiner-Gundersen in view of either Harris or Hines, and further in view of either Johnstone or Mauritz and either Jenkins or Jones each teach methods of entering wind data including its speed and direction, it would have been obvious to an artisan at a time prior to the invention to substitute one method for the other to achieve the predictable result of manually entering a wind speed and direction. Also, it is known to an artisan to be obvious to perform manually the steps of a prior automated process that accomplishes the same result is not sufficient to distinguish over prior art; which is the case here. Further, regarding scope of display to indicate wind speed and direction is analogous to discussion above regarding display indicating wind speed and direction or inclination or a ground condition that is incorporated herein.

6. Claims 6-7 are rejected under 35 U.S.C. 103(a) as being unpatentable over Jenkins in view of either Harris or Hines, and further in view of either Johnstone or Mauritz as applied to claim 1 above, and further in view of either Zeiner-Gundersen or Wilens (5779566). Jenkins in view of either Harris or Hines, and further in view of either Johnstone or Mauritz discloses claimed instrument (supra) except a wind speed and direction sensor. However, it is well settled in case law to make a prior manual activity automated. In re Venner et al., 120 USPQ 262 F.2d 91, 95, 120 USPQ 193, 194 (CCPA 1958) (Appellant argued that claims to a permanent mold

casting apparatus for molding trunk pistons were allowable over the prior art because the claimed invention combined “old permanent-mold structures together with a timer and solenoid which automatically actuates the known pressure valve system to release the inner core after a predetermined time has elapsed.” The court held that broadly providing an automatic or mechanical means to replace a manual activity which accomplished the same result is not sufficient to distinguish over the prior art.). Zeiner-Gundersen (sic) and Wilens (2:20-5:35, 7:17-27, 10:24-11:4, figs. 1-41, esp. 18-20) each teach an instrument including a wind speed and direction sensor to automatically input wind speed and direction for possible alteration to suggested golf club type based on determined range. Because Jenkins in view of either Harris or Hines, and further in view of either and either Zeiner-Gundersen or Wilens each teach methods of entering a wind speed and direction [that is used to offset range for computing a club suggestion], it would have been obvious to an artisan at a time prior to the invention to substitute one method for the other or to automate Jenkins method in view of either Harris or Hines, and further in view of either Johnstone or Mauritz via use of a sensor to automatically obtain a more accurate reading to achieve the predictable result of entering a wind speed and direction that can be used to suggest club based on determined range. Also, regarding scope of display to indicate wind speed and direction is analogous to discussion above regarding display indicating wind speed and direction or inclination or a ground condition that is incorporated herein.

Response to Arguments

7. Applicant's arguments filed 11/29/07 have been fully considered but they are not persuasive. Applicants' admission regarding computing at least one other correlated data set indicative of another golf club type and associated representative user range based on a

relationship in first data correlated data set being well known to an artisan is noted on page 8, lines 15-28. The lack of criticality of process to compute/enter remaining club data is noted due to instant disclosure relies upon known process as not teaching a unique new process and cited remarks lists general known process. Also, in response to applicant's argument that the references fail to show certain features of applicant's invention, it is noted that the features upon which applicant relies (i.e., 'laser' rangefinder) are not recited in the rejected claim(s). Although the claims are interpreted in light of the specification, limitations from the specification are not read into the claims. See *In re Van Geuns*, 988 F.2d 1181, 26 USPQ2d 1057 (Fed. Cir. 1993).

8. Applicant's arguments with respect to claims 1-12 and 23-24 have been considered but are moot in view of the new ground(s) of rejection.

Conclusion

9. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. Hurt, Hines ('406), Henriques and Krangle each disclose a golf range-finding instrument; while Cormier discloses an instrument to suggest club based on performance.

10. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event,

however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

11. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

12. Any inquiry concerning this communication or earlier communications from the examiner should be directed to M. A. Sager whose telephone number is 571-272-4454. The examiner can normally be reached on T-F, 0700-1730 hours.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Robert Pezzuto can be reached on 571-272-6996. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/M. A. Sager/
Primary Examiner, Art Unit 3714